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09/493,818 01/28/00 ALPEROVICH

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EXAMINER

IM22/0503

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ART UNIT

PAPER NUMBER

1756

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05/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/493,818

Applicant(s)

Alperovich et al.

Examiner

Martin J. Angebrannt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 9, 2000
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 20) ☐ Other: _____

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1 Claims ¹⁻¹⁰ ~~*~~ are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. MM 5/2/01

In claim 1, the dye, polymer, plasticizer [note misspelling in claim], surfactant and light stabilizer need to be properly introduced.

In claims 2 and 4, the claims should each be a single sentence with **one** period.

In claim 2, "porphyrines" should read --porphyrins--.

In claims 3 and 8, the language describing a group followed by "such as" is confusing as it is not clear if the coverage sought is for the group of just those specific members.

In claims 2,3,4,5 before "among" please insert --from--.

In claim 4, the species in parentheses should be deleted.

In claim 5, "therephthalate" is a misspelling.

Claims 6-10 should likely be dependent upon claim 5 as all of these claims lack antecedent basis for their recited species.

In claim 7, the recitation of trade names is not permitted as these may change in composition over time. Further, the claims language "polyvinyl alcohol, heated ..." should likely read --polyvinyl alcohol which has been heated--

In claim 7, the language "including" and the language " -divinyl styrene, divinylonitrile etc." should be deleted

Claim 9 lacks any steps and therefore is an improper method.

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2 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3 Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura et al. '792.

Tamura et al. '792 teaches optical recording media such as example 1-18 which mixes a cyanine dye (201) with a polymethine coloring agent coated on a polycarbonate substrate and dried. (1-1 is at column 28 and 1-18 is at column 31) The addition of other dyes, such as cyanine, phthalocyanine, xanthene dyes and stabilizers to the recording layer is disclosed. (25/15-26/26) The use of binders is disclosed. (26/61-65) The addition of plasticizers, surface active agents and the like to improve the film forming properties and stability of the coated film is disclosed. The examiner notes that the dispersants are surfactants (26/66-27/5) The use of various coating methods is disclosed. (27/12-23) The use of underlayers between the support and the recording layer to protect the substrate from coating solvents and increase adhesion of the recording layer is disclosed. These may be 5-100 nm in thickness. The use of various resins is disclosed, including UV curing resins, Thermosetting resins and thermoplastic resins. (27/30-53) Useful coating solvents are disclosed. (26-48) Useful substrates are also disclosed. (25/12-14)

It would have been obvious to add a binder and a plasticizer to the composition of example 1-18 of Tamura et al. '792 based upon the disclosure that these are desirable additives to

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the recording layer. Further, it would have been obvious to use a primer such as a thermosetting resin to increase the adhesion and the resistance of the substrate to damage from the coating solvents based upon the direction to do so.

4 Claims 1-5 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. '554.

Sato et al. '554 teaches with respect to example 8 in column 10 a recording medium formed from a cyanine dye and a plasticizer coated from a solvent. Useful plasticizers are disclosed (5/10-44) The addition of a binder is disclosed (3/27-35 and 3/57-4/10) The use of an undercoat layer is also disclosed. (7/8) Useful substrates are also disclosed, including polycarbonate, polyvinyl chloride and polyethylene resins. (2/4-15) Other useful dyes including phthalocyanine dyes are disclosed. (2/39-46)

It would have been obvious to add a binder to the composition of example 8 of Sato et al. '554 based upon the disclosure that these are desirable additives to the recording layer. Further, it would have been obvious to one skilled in the art to use other plasticizers based upon the disclosure of equivalence.

5 Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura et al. '792, in view of Sasakawa et al. '094.

Sasakawa et al. '094 teaches the coating of optical recording media where the drying includes heating up to 100 degrees C. (8/1-3) Useful solvents are disclosed. (4/20-6/25).

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In addition to the basis provide above, the examiner holds that it would have been obvious to modify the process of Tamura et al. '792, by drying at 100 degrees C based upon the direction within Sasakawa et al. '094 that this is known in the art and produces useful phthalocyanine recording media with a reasonable expectation of success.

6 Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura et al. '792, in view of Sasakawa et al. '094 and further in view of Arahara '516.

Arahara '516 teaches the use of various dyes useful in optical recording media and discloses the equivalence of these.

In addition to the basis provided above, the examiner holds that it would have been obvious to use other dyes, such as those disclosed by Arahara '516 in the recording media of Tamura et al. '792 as modified by Sasakawa et al. '094 with a reasonable expectation of forming a useful recording medium based upon the disclosure of equivalence within the art of these dyes.

7 Claims 1-5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. '554, in view of Sasakawa et al. '094.

In addition to the basis provide above, the examiner holds that it would have been obvious to modify the process of Sato et al. '554, by drying at 100 degrees C based upon the direction within Sasakawa et al. '094 that this is known in the art and produces useful phthalocyanine recording media with a reasonable expectation of success.

8 Claims 1-5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. '554, in view of Sasakawa et al. '094 and further in view of Arahara '516.

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In addition to the basis provided above, the examiner holds that it would have been obvious to use other dyes, such as those disclosed by Arahara '516 in the recording media of Sato et al. '554 as modified by Sasakawa et al. '094 with a reasonable expectation of forming a useful recording medium based upon the disclosure of equivalence within the art of these dyes.

9 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10 Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 09/493267. Although the conflicting claims are not identical, they are not patentably distinct from each other because they seek coverage for overlapping subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Angebrannt whose telephone number is (703) 308-4397.

I am normally available between 7:30 AM and 5:00 PM, Monday through Thursday and 7:30 AM and 4:00 PM on alternate Fridays.

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If repeated attempts to reach me are unsuccessful, my supervisor may be reached at (703) 308-2464.

Facsimile correspondence should be directed to (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Martin J. Angebranndt
Primary Examiner, Group 1750
May 2, 2001